

U.S. APPLICATION NO. 09/688,863  
AMENDMENT UNDER 37 C.F.R. § 1.111

**REMARKS**

Upon entry of this amendment, claims 1, 2 and 4-11 are all the claims pending in the application. Claim 3 has been canceled. New claims 7-11 have been added. No new matter has been added.

§ Applicant thanks the Examiner for acknowledging the claim to foreign priority and for confirming that the certified copy of the priority document was received.

Applicant also thank the Examiner for acknowledging Applicant's election without traverse of Species I, claims 1-4 and 6.

17 **I. Drawing Objections**

17 1) Figures 7 and 8 are objected to by the Examiner. The Examiner asserts that different reference numerals for similar parts should be used whenever a different embodiment is shown. The Examiner cites MPEP §608.01(g) in support of the objection. The cited section of the MPEP states that "reference characters must be properly applied, no single reference character being used for two different parts or for a given part and a modification of such part."

17 Thus, while the cited MPEP section requires that different reference characters be used for different parts, the section does not require that different reference characters for similar parts be used whenever a different embodiment is shown, as alleged by the Examiner. Therefore, the Examiner is respectfully requested to reconsider and withdraw the objection. If the Examiner

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persists in the objection, Applicant respectfully requests that the Examiner particularly point out language in the MPEP in support of the objection.

**II. Claim Rejections under 35 U.S.C. § 102(b)**

Claims 1-4 and 6 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Payr (U.S. Patent No. 5,179,883). Applicant respectfully traverses this rejection on the following basis.

Claim 1 has been amended to incorporate the features of dependent claim 3. Claim 1, as amended, defines a new and unique combination of elements which form a cutting machine. Included among the features of this new cutting machine is a support table and a level adjusting mechanism which adjusts a relative position between the support table and first and second rotary cutters in an up and down direction according to a thickness of a cardboard plate and for setting a boundary between the respective depth of cutting by first and second rotary cutters to a value substantially equal to one half of a thickness of the cardboard plate. Applicant respectfully submits that the claimed combination, including at least these features, is neither disclosed nor suggested by Payr.

The Examiner takes the position that Payr discloses the above mentioned features. In particular, the Examiner asserts that Payr discloses a support table 12 having an inherent level adjusting mechanism as claimed and cites Figure 2 and column 3, lines 37-47 in support. Applicant respectfully disagrees.

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Payr discloses a lifting table 12 provided beside each of a plurality of supports 3. The lifting table is normally positioned beneath the support 3. When a piece of wood is transported to the end of conveyor belt 13, the lifting table 12 rises from beneath the support 3 up to the end of the feeding conveyor 13. Each lifting table 12 is equipped with a conveyor chain which enables the wood to be conveyed from the conveyor 13 to the lifting table 12.

After the wood is on the lifting table 12, the lifting table 12 is lowered so that the wood is placed on supports 3. The wood is then clamped into place by clamping jaws 2 which are disposed on movable clamping trestles 1. As seen in figure 2, the clamping trestles 1 are movable in a horizontal direction so that the wood can be securely held in place while it is being cut.

The clamping trestles 1 and corresponding clamping jaws 2 can be positioned so as to set a desired cutting thickness of the wood in a horizontal direction (see Figure 2), but the clamping trestles 1 and clamping jaws 2 are not able to adjust a relative position between the support table 12 and the rotary cutters in a vertical direction according to the thickness of the wood. Nor are the clamping trestles 1 and clamping jaws 2 able to set a boundary between the respective depth of cutting of the rotary cutters to a value substantially equal to one half of the thickness of the wood.

Therefore, Payr fails to disclose or suggest all of the features of claim 1. Namely, Payr fails to disclose or suggest an adjusting mechanism which adjusts a relative position between the support table and first and second rotary cutters in an up and down direction according to a thickness of a cardboard plate. Further, Payr fails to disclose or suggest a level adjusting

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mechanism for setting a boundary between the respective depth of cutting by the first and second rotary cutters to a value substantially equal to one half of a thickness of the cardboard plate.

Accordingly, Applicant submits that claim 1 is allowable over the applied art and respectfully requests that the rejection be reconsidered and withdrawn. If the Examiner persists in this rejection, Applicant respectfully requests that the Examiner particularly point out the structure and passages in Payr which are being relied upon for teaching the above discussed features.

In addition to citing Figure 2 and column 3, lines 37-47, the Examiner also alleges that a level adjusting mechanism as claimed is inherent to Payr. Again, Applicants respectfully disagree.

The question of whether a claim limitation is “inherent” in a prior art reference is a factual issue. *See Continental Can Co. U.S.A., Inc. v. Monsanto Co.*, 948 F.2d 1264, 1268 (Fed. Cir. 1991). Although extrinsic evidence may be consulted regarding an asserted inherent characteristic, “[s]uch evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.” *Id.* at 1268 (emphasis added). Moreover, inherency “may not be established by probabilities or possibilities.” *Id.* at 1269 (emphasis added).

In relying on the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original); MPEP§ 2112.

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Since the Examiner has not come forward with any factual basis or technical reasoning as to why the adjusting mechanism as claimed would necessarily be present, Applicant submits that the Examiner has not established that all of the limitations of claim 1 are disclosed or suggested by Payr.

Claims 2, 4 and 6 depend upon claim 1 and therefore incorporate all the limitations thereof. Accordingly, Applicant submits that claims 2, 4 and 6 are allowable at least by virtue of their dependency.

### **III. New Claims**

New claims 7-11 have been added to further define the invention. Applicant submits that these claims are patentable based on the combination of features contained therein.

### **IV. Conclusion**

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

Submitted herewith is a Petition For Extension Of Time with fee.

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Applicants hereby petition for any extension of time which may be required to maintain the pendency of this case, and any required fee, except for the Issue Fee, for such extension is to be charged to Deposit Account No. 19-4880.

Respectfully submitted,

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APPENDIX

VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

**Claim 3 is canceled.**

**The claims are amended as follows:**

1. (Amended) A cutting machine for cutting a flat cardboard plate having a cardboard, said cutting machine comprising:

a first rotary cutter for cutting an upper portion of the flat cardboard plate;

a second rotary cutter rotatable in a direction counter to a direction of rotation of the first rotary cutter for cutting a lower portion of the flat cardboard plate;

a drive mechanism for driving the first and second rotary cutters relative to the flat cardboard plate along a single cutting line to cut the flat cardboard plate along such cutting line[.]; and

a support table for supporting from below the flat cardboard plate, and a level adjusting mechanism for adjusting a relative position between the support table and the first and second rotary cutters in a direction up and down according to a thickness of the flat cardboard plate to be cut and for setting a boundary between respective depth of cutting by the first and second rotary cutters to a value substantially equal to one half of a thickness of the flat cardboard plate.

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4. (Amended) The cutting machine for cutting the flat cardboard plate as claimed in Claim [3]1, wherein the level adjusting mechanism is operable to selectively elevate and lower the support table.

6. (Amended) The cutting machine for cutting the flat cardboard plate as claimed in Claim 1, further comprising [a support table for supporting from below the flat cardboard plate, and] a retaining mechanism for pressing a portion of the flat cardboard plate on a trailing side of the cutting line with respect to a direction of feed of the flat cardboard plate against the support table to retain the flat cardboard plate immovable during a cutting operation.

**Claims 7-11 have been added as new claims**